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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#9/Response
11/2/99
V. Vannall

Applicant: David G. McCarthy

Examiner: B. Hammond

Title: Retractable Receptacle For Furniture

Group Art Unit: 2833

Serial No. 08/951,276

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Hon. Commissioner of Patents & Trademarks
Washington, D.C. 20231

Attn: Box AF

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Applicant respectfully requests reconsideration and withdrawal of the final rejection of the above identified patent application made in the Official Action dated August 31, 1999.

At page 2, paragraph 1 of the Official Action dated August 31, 1999, the Examiner has acknowledged that the prior Official Ation dated June 10, 1999 failed to address pending Claims 9 and 14. Accordingly, the Examiner has withdrawn the finality of the Official Action dated June 10, 1999, and has issued a final action dated August 31, 1999 which addresses pending Claims 9 and 14.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, on 10/29/99
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Applicant initially notes that page 2, paragraphs 2 and 3 of the Official Action, which object to the drawings under 37 C.F.R. 1.83(a) and (b), are identical to paragraphs 2 and 3 of the Official Action dated June 10, 1999. Applicant has completely responded to the drawing objections in the Amendment After Final Rejection filed on August 9, 1999. Additionally, Applicant's response filed on August 9, 1999 included proposed drawing corrections. The latest Official Action fails to address Applicant's responses to the drawing objections in the Amendment After Final Rejection filed on August 9, 1999. Additionally, the cover sheet of the latest Official Action states that the proposed drawing corrections filed by Applicant with the August 9, 1999 response have been disapproved, but provides no reason for the disapproval.

At page 3, paragraph 5 of the latest Official Action, the Examiner has rejected Claims 1 - 20 under 35 U.S.C. Section 112, first paragraph, as containing subject matter not described in the specification as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention. Applicant initially notes that this formal ground of rejection has been made for the first time in the second final action issued by the Examiner.

Applicant respectfully submits that each structural element to which the Examiner has objected will clearly be understood by

a person having ordinary skill in the relevant art in conjunction with Applicant's specification and drawings. For example, expressions such as "means for coupling said housing", "means for resiliently biasing", "means for selectively displacing", and "locking means", are terms which will clearly be understood by persons skilled in the art, in conjunction with Applicant's written disclosure and drawings.

The Examiner also contends that the expression "open top" of the housing is a term which will not be enabling to a person skilled in the art. In the first instance, Applicant's specification does not disclose an "open top" of a housing, but on the contrary, discloses an "open top" of a table, as for example, opening 12 in the top surface 8 of the table top 4, as illustrated by Figures 1 and 2 of the drawing. Applicant submits that a person having ordinary skill in the relevant art would clearly understand how to make and use an opening in the top surface of a table as described and illustrated in Applicant's original specification and drawings.

Applicant emphasizes that a patent specification is enabling under 35 U.S.C. Section 112, first paragraph, if the disclosure is sufficient to enable a person having ordinary skill in the art to make and use the invention without undue experimentation. See, for example, deGeorge v. Bernier, 226 USPQ 758 (Fed. Cir. 1985); Scripps Clinic & Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001, 18 USPQ 2d 1896 (Fed. Cir. 1991). Moreover, it

is well established that in determining if a specification is enabling, a specification need not disclose what is well known in the art. See, for example, Lindemann Machinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481 (Fed. Cir. 1984); Hybritech Inc. v. Monoclonal Antibodies Inc., 231 USPQ 81 (Fed. Cir. 1986); Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 231 USPQ 649 (Fed. Cir. 1986); and Spectra-Physics, Inc. v. Coherent, Inc. 2 USPQ 2d 1737 (Fed. Cir. 1987).

Applicant respectfully submits that each of the terms identified in paragraph 5 of the Official Action to which the Examiner has objected, are descriptions which will readily be understood by persons skilled in the art in conjunction with Applicant's specification, and are directed to subject matter which is known to the art. Applicant respectfully requests reconsideration and withdrawal of the rejections of the claims on the grounds that the specification fails to provide an enabling disclosure.

At paragraphs 7 - 9 of the latest Official Action, the Examiner has rejected the claims based upon the same prior art applied at paragraph 7 - 9 of the Official Action dated June 10, 1999. Additionally, in the latest Official Action, Claims 9 and 14 have been rejected under 35 U.S.C. Section 103(a) over United States Patent No. 4,747,788 (See paragraph 9 of the latest Official Action).

Applicant relies upon and incorporates by reference the arguments presented in support of the rejected claims made in Applicant's prior responses filed on March 12, 1999 and August 9, 1999. With regard to Claims 9 and 14 which were not acted on in the prior action, these claims are dependent claims and include all features of the respective parent claims. Applicant submits that these two dependent claims are allowable, at least for the same reasons advanced in support of the allowance of their respective parent claims in Applicant's prior responses. Applicant therefore respectfully submits that all pending claims are allowable over the prior are applied in the latest Official Action.

At page 5, paragraph 10 of the Official Action, the Examiner states that "In response to applicant's argument the examiner has not addressed all of the arguments presented by the applicant There is insufficient structural relationship recited between the elements in the claims, applicant need to submit approved drawings for the claimed elements shown". Applicant does not understand the intended meaning of this statement by the Examiner. Applicant reiterates his prior position that the Examiner has failed to address applicant's previous arguments made in support of allowance of the claims. Applicant fails to understand what the Examiner means by "insufficient structural relationship recited between the elements in the claims", since the Examiner has failed to specify what this "insufficient structural relationship" is. Applicant also fails to understand

the statement that "applicant needs to submit approved drawings with the claimed elements shown", since Applicant has already submitted drawings to overcome objections raised in the Official Action dated June 10, 1999, and the Examiner has disapproved these proposed corrections in the Official Action dated August 31, 1999 without providing any reason for the disapproval.

In light of the above, Applicant respectfully requests clarification by the Examiner regarding the "insufficient structural relationship recited between the elements in the claims", and the basis for the disapproval of the drawings submitted with Applicant's response filed on August 9, 1999. With regard to the "insufficient structural relationship" objection, Applicant notes that no rejection of the claims under 35 U.S.C. Section 112, second paragraph, has been made in the Official Action dated August 31, 1999.

Applicant respectfully submits that this application is in condition for allowance, and requests that all rejections in the outstanding Official Action be reconsidered and withdrawn.

Respectfully submitted,

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